



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/801,309

Applicant: William E. Italia et al.

Filed: March 16, 2004

TC/AU: 2617 (Confirmation No. 1978)

Examiner: HOLLIDAY, JAIME MICHELE

Docket No.: 252274 (Client Reference No. GP-304136)

Customer No.: 23460

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants request review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the following sheets.

Respectfully submitted,

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Date: May 21, 2008

*REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW*Claims 16-20

Claims 16-20 were previously rejected on the grounds that the term "computer-readable media" was not clear and might have encompassed non-statutory subject matter. Whatever the merits of that assertion may have been, claims 16-20 were cancelled last year in order to expedite prosecution.

Nonetheless, the rejections of claims 16-20 persist today as if these claims were still pending. Because these claims were cancelled many months ago, it would seem that the Examiner has overlooked part of the prior response.

The Prior Art Rejections

The concerns raised by the aforementioned lack of focus in this case only grow stronger upon reading the "Response" section in the latest Action. The first assertion of the "Response" section is that the elements relied upon for patentability are missing from the claims. As with the §112 rejections, this assertion was made without giving full attention to the file. In particular, the Action stated as follows:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., assigning the local dialing number to the mobile device) are not recited in the rejected claim(s).

However, the argued distinction is indeed expressly recited in all of the claims. Applicants respectfully draw the Office's attention to independent claims 1 and 11.

Claim 1: "... *assigning the MDN providing local calling access to the MCD* ...".

Claim 11: "... *assigning the MDN providing local calling access to the MCD* ..."

Thus, the claims clearly recite the very distinction that the Examiner has stated to be missing. Perhaps as a contingency, the Action then asserts that the Howe reference nonetheless *does*

teach a step of assigning a local number to a mobile unit. This assertion, too, is simply and plainly false. The Action asserts the following in this regard (see the Final Action, pp. 2-3):

Since the mobile terminal is associated with the MIN of the data unit, which is connected to the mobile terminal and has phone capabilities, the assigned TLDN to the data unit will used to route the call to the mobile phone.

This statement is conclusive, and the conclusion does not relate in any way to the actual claims at issue. It is irrelevant that the assigned TLDN is "used to route" the call to the mobile phone. That fact that a particular number is used for routing somewhere in the transmission process doesn't change the mobile phone's number, a feature that is expressly required by the claims. Rather, Howe's data unit calls Howe's mobile unit via the *mobile unit's* own assigned number -- not, of course, the *data unit's* own local number.

More consistent logic is sorely needed, and can be had by referencing the undisputed actual teachings of Howe:

1. The "data unit" of Howe is stationary - it is *not* a mobile device of any sort,
2. Only this "data unit" of Howe is assigned a local phone number, and
3. The "mobile unit" of Howe is distinct from the "data unit" of Howe, and has a *different* phone number from the "data unit."

Based on the Office Actions, the Examiner does not disagree with the above. Rather, the Examiner apparently feels that assigning a local number to a stationary data unit is the same as assigning a local number to a mobile unit since the mobile unit and data unit could be "associated" with one another during use. However, the claim doesn't pertain to assigning a number to a piece of equipment that at some point may be momentarily in communication *with* the mobile device – the claims call for assigning a particular number *to the mobile device itself*. That is exactly what Howe fails to teach. Please reverse the pending rejections.

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